

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of John M. Stewart,
Bradley J. Steeves, and Karl Vernes
Application No. 10/716,314
Filed November 18, 2003

Examiner: N.Y.A.
Art Unit: 1656
Confirmation No. 7296

PARALYTIC PEPTIDE FOR USE IN NEUROMUSCULAR THERAPY

Attorney Docket No. P26,473-A USA

Filed Electronically by Marc S. Segal on November 30, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
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**Reply to Examiner's Requirement for Restriction
Election, As Set Forth in the Action Dated October 31, 2006**

In response to the Examiner's Requirement for Restriction, as set forth in the Action dated October 31, 2006, applicants elect hereby to prosecute the claims of Group III, that is, Claims 23, 24 and 32 drawn to a method of providing analgesia by administering SEQ ID NO:2. Applicants confirm their right to file divisional applications which include the non-elected claims.

Applicants traverse respectfully the Restriction Requirement. The Examiner's attention is further directed to MPEP §803, which states (emphasis added) (internal citations omitted):

If the search and examination of an entire application can be made *without serious burden, the examiner must examine it on the merits*, even though it includes claims to independent or distinct inventions.

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent or distinct as claimed; *and*

(B) *There must be a serious burden on the examiner if restriction is required.*

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

Applicants respectfully submit that the Examiner's Action does not explain why it would be "a serious burden" for the Examiner to perform a search and examination of the entire application. Accordingly, the Examiner's Requirement does not satisfy an essential criterion for a proper Requirement for Restriction, as set forth in the MPEP.

Furthermore, applicants respectfully submit that it would *not* be a serious burden for the Examiner to search and examine the entire application. The methods of Groups II, III, and IV utilize the peptide of Group I. Similarly, Group VI is drawn to a nucleic acid encoding Group I and Group V is drawn to an antibody of Group I. Accordingly, a Search of Group I would necessarily include a search of Groups II through VI. In view of this relationship, applicants assert that the examiner has no added burden to examine the entire application at the same time as the Group I claims. Accordingly, applicants respectfully request that the Examiner withdraw the Restriction Requirement.